UNITED STATES PATENT AND TRADEMARK OFFICE

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LOWE HAUPTMAN HAM & BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

EXAMINER
ELAHEE, MD S

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 February 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7-11,13-42 and 44-48* is/are pending in the application.

     4a) Of the above claim(s) *28-42,44,47 and 48* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7-11,13-27,45 and 46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   This action is responsive to an amendment filed on 02/14/2008. Claims 1, 7-11, 13-42

and 44-48 are pending. Claims 2-6, 12 and 43 have been previously cancelled. Claims 44-48

have been newly added. Group I of claims 1, 7-11, 13-27, 45 and 46 is elected and Group II of

claims 28-42, 44, 47 and 48 is withdrawn.

Response to Arguments

2.   Applicant's arguments filed in the 02/14/2008 Remarks with respect to claims 1, 7-11 and

13-27 have been fully considered but they are not persuasive because of the following:

Regarding claims 1 and 18, the applicant argues on pages 15-16 that controlling the

operation of a mobile phone by location, as disclosed by Valentine et al., is not in the same

technical field, or a related technical field, to electronic transaction cards, as disclosed by Tarbox

and that one of ordinary skill in the art would not make an electronic transaction of the type

discussed by Tarbox location triggered. Examiner respectfully disagrees with the argument. In

order to receive a service a mobile user must have to pay for the service to his service provider.

Therefore, it is inherent for Valentine. The only missing element is conducting a transaction of a

user purchasing a service or product. Tarbox teaches this limitation (see. col.3, lines 19-23, col.5,

lines 16-29). It clearly means that both Valentine and Tarbox are in the same technical field, or a

related technical field.

The applicant further argues on page 16 that at the November 22, 2005, interview, the examiners were unable to identify what, in the proposed combination of Valentine et al. and Tarbox is the "transaction" of claim 1. Examiner respectfully disagrees with the argument. There is no such a record in interview summary that examiners were unable to identify what, in the proposed combination of Valentine et al. and Tarbox is the "transaction" of claim 1 (see interview summary on 11/22/2005).

The applicant further argues on page 17 that Since neither the cell phone operating company nor the cell phone user is interested in (1) performing more electronic transactions "of product such that a user can make a transaction in a particular *area* whenever he needs" or (2) conducting "one or more electronic transaction of product such that a user can enjoy making transactions in a particular place he is authorized without having any inconvenience," the alleged motivations are completely illogical. Examiner respectfully disagrees with the argument. It is because, the word "transaction" is too broad. The applicant is silent about the location of "transaction" whether the "transaction" is conducted by a mobile phone with a banking system or "transaction" is conducted by credit card. Therefore, the proposed combination is proper.

Thus the examiner maintains the rejection of the claims in view of Valentine and Tarbox.

Claims 7-11, 13-27, 45 and 46 are rejected for the same reasons as discussed above with respect to claim 1.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

> 1.   Determining the scope and contents of the prior art.
> 2.   Ascertaining the differences between the prior art and the claims at issue.
> 3.   Resolving the level of ordinary skill in the pertinent art.
> 4.   Considering objective evidence present in the application indicating obviousness
>   or nonobviousness.

5.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6.   Claims 1, 8-11, 13, 14, 16-19 and 23-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Valentine et al. (U.S. Patent No. 6,011,973) in view of Tarbox (U.S. Patent

No. 5,705,798).

Regarding claim 1, with respect to Figures 1-3, Valentine teaches a service delivery method comprising the steps of:

qualifying the user as authorized to benefit from a particular location-triggered service (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 20).

Valentine teaches location data indicative of at least one location where service delivery is to be triggered (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 20).

Valentine further teaches subsequently detecting a location match between the location of the user, as indicated by the location of a mobile entity associated with the user, and a location indicated by the location data (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 20).

However, it is not clear whether Valentine teaches "conducting a transaction of a user purchasing a service or product". Tarbox teaches conducting a transaction of a user purchasing a service or product (fig.4; col.3, lines 19-23, col.5, lines 16-29). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Valentine to incorporate the feature of conducting a transaction of a user purchasing a service or product as taught by Tarbox. The motivation for the modification is to do so in order to perform more electronic transaction of product such that a user can make a transaction in a particular area whenever he needs.

Valentine further does not specifically teach "a user-associated instance of executable program, for implementing the particular service, the program instance being customized for said transaction and distinct from the location data" and "initiating execution of the user-associated program instance to deliver the particular service to the user". Tarbox teaches a user-associated instance of executable program, for implementing the particular service, the program instance

being customized for the transaction and distinct from the location data and initiating execution

of the user-associated program instance to deliver the particular service to the user (fig.4; col.3,

lines 19-23, col.5, lines 16-29). Thus, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify Valentine to incorporate a user-associated

instance of executable program, for implementing the particular service, the program instance

being customized for said transaction and distinct from the location data as well as initiating

execution of the user-associated program instance to deliver the particular service to the user as

taught by Tarbox. The motivation for the modification is to do so in order to conduct one or

more electronic transaction of product such that a user can enjoy making transaction in a

particular place he is authorized without having any inconvenience.

Regarding claim 8, Valentine does not specifically teach "the user-associated program-

code instance is a customization of a generic program for implementing the service". Tarbox

teaches that the user-associated program-code instance is a customization of a generic program

for implementing the service (col.3, lines 19-23, col.5, lines 16-29). Thus, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify Valentine

to incorporate the user-associated program-code instance being a customization of a generic

program for implementing the service as taught by Tarbox. The motivation for the modification

is to have doing so in order to provide customized display features to a user.

Regarding claim 9, Valentine teaches that service delivery is conditional upon the user downloading a location information [i.e., inputting a personal identification code] (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 3).

Regarding claim 10, Valentine teaches that the message [i.e., service] delivery only continues whilst the user's current location matches with a location indicated by the location data (col.1, lines 54-67, col.2, lines 1-14, 45- 60).

Regarding claim 11, Valentine teaches that once initiated, service delivery is continued until completion (col.1, lines 54-67, col.2, lines 1-14, col.3, lines 21-40).

Regarding claim 13, Valentine teaches that the location data is indicative of multiple locations (col.3, lines 4-40).

Regarding claim 14, Valentine does not specifically teach "the user-associated program-code instance is a customization of a generic program for implementing the service". Tarbox teaches that multiple user-associated program instances associated with different services instances to be delivered to the same user, are stored in a memory [i.e., common repository] (fig.4; col.3, lines 19-23, col.5, lines 16-29). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Valentine to incorporate multiple user-associated program instances associated with different services instances to be delivered to the same user, are stored in a common repository as taught by Tarbox. The motivation for the

modification is to have doing so in order to provide a storage for different programming

instructions.

Regarding claim 16, Valentine teaches that the current user location is provided to the

entity carrying out location matching in step (b) by a trusted location service provider and is

inherently digitally-signed by the latter (col.2, line 45- col.3, line 20).

Regarding claim 17, Valentine teaches that the updating program [i.e., user-associated

program instance] specifies a particular number of times (including only once) that the updating

program can be run (col.2, line 45- col.3, line 49). (Note; periodic location update with the

period is set by the base station, it is inherent that updating program can be run only once.)

Claim 18 is rejected for the same reasons as discussed above with respect to claim 1.

Furthermore, Valentine teaches a memory 150 [i.e., location-data repository] (fig.1);

Valentine further teaches a database 190 [i.e., service repository] (fig.1; col.3, lines 9-13);

Valentine further teaches a base station 180 [i.e., service factory] (fig.1);

Valentine further teaches a cellular telephone network 170 [i.e., qualification subsystem]

to benefit from a particular location-triggered service, the cellular telephone network being

arranged, upon determining that the user is so qualified, both to store in the memory location

data indicative of at least one location where service delivery is to be triggered, and also to create

in the base station (fig.1; col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 20);

Valentine further teaches a service execution environment for executing updating program [i.e., user-associated program instances] (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 3);

Valentine further teaches a location-match subsystem for detecting a location match between the location of the user, as indicated by the location of a mobile entity associated with the user, and a location indicated by the location data (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 20).

Regarding claim 19, Valentine teaches that the memory [i.e., location repository] is incorporated in the mobile entity associated with the user (fig.1; col.2, lines 45- 60).

Regarding claim 23, Valentine teaches that the updating program [i.e., user-associated program instance] is stored in the mobile entity, the detection of a location match in step (b) resulting in the location information [i.e., program instance] being executed at the mobile entity (col.2, line 45- col.3, line 49).

Regarding claim 24, Valentine teaches that the updating program [i.e., user-associated program instance] is stored in the mobile entity, the detection of a location match in step (b) resulting in the location information [i.e., program-code instance] being passed from the mobile entity to a service provider system where it is executed (col.2, line 45- col.3, line 49).

Regarding claim 25, Valentine teaches that the updating program [i.e., user-associated program-code instance] is stored in the service provider system, the detection of a location match in step (b) resulting in the program-code instance being inherently executed by the service provider system (col.2, line 45- col.3, line 49).

Regarding claim 26, Valentine teaches that the updating program [i.e., user-associated program instance] and the location data are stored in the same entity (col.2, line 45- col.3, line 49).

Regarding claim 27, Valentine teaches that the updating program [i.e., user-associated program instance] and the location data are stored in the different entities, the location data having associated data enabling the entity storing the program instance to be informed when a location match is detected in step (b) (col.2, line 45- col.3, line 49).

7.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine et al. in view of Tarbox further in view of Eldridge et al. (U.S. Patent No. 6,601,102).

Regarding claim 7, Valentine teaches that the program [i.e., user-associated program instance] includes user identity data and is digitally-signed by the party that carried out the qualification step (a) whereby the service provider system can check the authenticity of the data in the program (abstract; fig.3; page 4, lines 14-20, page 10, lines 6-14, 23, 24).

However, Valentine in view of Tarbox does not specifically teach "the user mobile entity having an associated key pair, formed by a public-key and a private key, and being required by the service provider system to authenticate its identity by using its private key to sign and return data proposed by the service provider system". Eldridge teaches that the user mobile entity having an associated key pair, formed by a public-key and a private key, and being required by the server [i.e., service provider system] to authenticate its identity by using its private key to sign and return data proposed by the server (fig.1, 2; col.4, lines 9-15, 42-67, col.5, lines 1-8, col.7, lines 5-29, 48-51, 56-67, col.8, lines 1-25). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Valentine in view of Tarbox to incorporate the user mobile entity having an associated key pair, formed by a public-key and a private key, and being required by the service provider system to authenticate its identity by using its private key to sign and return data proposed by the service provider system as taught by Eldridge. The motivation for the modification is to do so in order to perform secure token-based document transaction services using key pair.

8.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine et al. in view of Tarbox further in view of Okamoto et al. (U.S. Pub. No. 2004/0128257).

Regarding claim 15, Valentine in view of Tarbox does not specifically teach that the user-associated program instance is passed by the party that carries out the qualification step to the user or to a third-party, the program instance being digitally signed by the party that carries out the qualification step whereby to enable an eventual service deliverer to check the origin and

authenticity of the user-associated program instance. Okamoto teaches that the token [i.e., user-associated program instance] is passed by the party that carries out the qualification step to the user or to a third-party, the program instance being digitally signed by the party that carries out the qualification step whereby to enable an eventual service deliverer to check the origin and authenticity of the token (abstract; fig.7; page 4, paragraphs 0048, 0049, page 7, paragraph 0108, page 8, paragraphs 0134-0136, 0139, 0142). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Valentine in view of Tarbox to incorporate the user-associated program instance is passed by the party that carries out the qualification step to the user or to a third-party, the program instance being digitally signed by the party that carries out the qualification step whereby to enable an eventual service deliverer to check the origin and authenticity of the user-associated program instance as taught by Okamoto. The motivation for the modification is to do so in order to perform secure transaction associated with a user.

9.   Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine et al. in view of Tarbox further in view of Suzuki (U.S. Patent No. 6,129,274).

        Regarding claim 20, Valentine in view of Tarbox fails to teach "the service repository is incorporated in the mobile entity associated with the user". Tarbox teaches that the transaction history storage area 86 [i.e., service repository] is incorporated in the personal digital shopping assistant 10 [i.e., mobile entity] associated with the user (abstract; fig.1, 2; col.7, lines 58-67, col.8, lines 1-14, 54-61, col.10, lines 19-26, col.11, lines 3-19). Thus, it would have been obvious

to one of ordinary skill in the art at the time the invention was made to modify Valentine in view of Tarbox to allow the service repository being incorporated in the mobile entity associated with the user as taught by Tarbox. The motivation for the modification is to do so in order to store a shopping transaction history data.

Regarding claim 21, Valentine teaches that the message [i.e., service] execution environment is incorporated in the mobile entity associated with the user (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 3).

10.   Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine et al. in view of Tarbox further in view of Suzuki further in view of Okamoto et al. (U.S. Pub. No. 2004/0128257).

Claim 22 is rejected for the same reasons as discussed above with respect to claim 15. Furthermore, Valentine teaches that the service execution environment is separate from the mobile entity but can inter-communicate with the latter via a wireless infrastructure at least when the mobile entity is positioned to give rise to a location match (col.1, lines 54-67, col.2, lines 1-14, line 45- col.3, line 20).

11.   Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine et al. in view of Tarbox further in view of Seazholtz et al. (U.S. Patent No. 5,594,789).

Regarding claims 45 and 46, Valentine in view of Tarbox fails to teach "the user associated program instance includes instructions advising the user to perform an act associated with the purchased service or product, the act being in addition to and different from the purchased service or product". Tarbox teaches that the user associated program instance includes instructions advising the user to perform an act associated with the purchased service or product, the act being in addition to and different from the purchased service or product (col.12, lines 9-22). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Valentine in view of Tarbox to incorporate the feature of the user associated program instance to include instructions advising the user to perform an act associated with the purchased service or product, the act being in addition to and different from the purchased service or product as taught by Tarbox. The motivation for the modification is to do so in order to identify the product a user desires to purchase and the mode of payment to be used.

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action. .

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536.

The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (571) 272-7547.   The fax phone number for the

organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/MD S ELAHEE/
MD SHAFIUL ALAM ELAHEE
Examiner
Art Unit 2614
October 4, 2008